

SPC#
PATENT

Attorney Docket No. UCSD-04765

JC17 Rec'd PCT/PTO 2 5 JUN 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ronald D. Vale *et al.*
Serial No.: 09/673,222
Filed: 10/13/00
Entitled: Assays for the Detection of Microtubule Depolymerization Inhibitors

Group No.:
Examiner:

**RESPONSE TO NOTIFICATION OF MISSING
REQUIREMENTS UNDER 35 USC 371 IN
THE DESIGNATED ELECTED OFFICE
MAILED APRIL 26, 2001**

Application Processing Division,
Special Processing and Correspondence Branch
Assistant Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING UNDER 37 CFR § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231, on June 21, 2001.

By: Marilyn Moy
Marilyn Moy

DISK TO STICK

DATE:

Sir or Madam:

In response to the Notification of Missing Requirements Under 35 USC 371 in the Designated Elected Office mailed 4/26/01 (a copy of which is enclosed), applicants submit the following documents:

1. Amendment to Drawings Under 37 C.F.R. § 1.121(a)(3)
2. Preliminary Amendment and Response to Notification of Missing Requirements Under 35 USC 371 in the Designated Elected Office
3. Sequence Listing in paper copy and on a computer-readable diskette
4. Certificate re: Sequence Listing

The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 08-1290. An originally executed duplicate of this transmittal is enclosed for this purpose.

Dated: June 21, 2001

Kamrin T. MacKnight
Kamrin T. MacKnight
Registration No. 38,230
MEDLEN & CARROLL, LLP
220 Montgomery Street, Suite 2200
San Francisco, California 94104
415/705-8410



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/673222	VALE R	UCSD-04765
INTERNATIONAL APPLICATION NO.		
PCT/US99/08086		
I.A. FILING DATE	PRIORITY DATE	
13 APR 99	14 APR 98	
DATE MAILED: 26 APR 2001		

MEDLEN & CARROLL
SUITE 2200
220 MONTGOMERY STREET
SAN FRANCISCO, CA 94104

RECEIVED
MAY 02 2001
MEDLEN & CARROLL

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☐ an Elected Office (37 CFR 1.495):

- | | |
|---|---|
| <input type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Indication of Small Entity Status. |
| <input type="checkbox"/> Copy of the international application. | <input type="checkbox"/> Translation of the international application into English. |
| <input type="checkbox"/> Oath or Declaration of inventor(s). | <input type="checkbox"/> Translation of Article 19 amendments into English. |
| <input type="checkbox"/> Copy of Article 19 amendments. | <input type="checkbox"/> Other: |
| <input type="checkbox"/> Priority Document. | |
| <input type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any. | |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English. | |

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- | | |
|---|---|
| <input type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Copy of the international application. |
|---|---|

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☐ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of \$_____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.
7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed: ☐ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PTO-875 ☒ PCT/DO/EO/920

Paulette Kidwell, Paralegal

FORM PCT/DO/EO/905 (March 2001)

Telephone: 703-305-3656



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/673222	VALE	R UCSD-04765
INTERNATIONAL APPLICATION NO.		
PCT/US99/08086		
I.A. FILING DATE	PRIORITY DATE	
13 APR 99	14 APR 98	

DATE MAILED: 26 APR 2001

**NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE
DISCLOSURES**

Applicant has submitted papers under 35 U.S.C. 371 to enter the national stage in the United States of America. The items indicated below, however, are missing. The period within which to correct the deficiency noted below and avoid abandonment is set forth in the accompanying Notification.

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- ☐ The application fails to comply with the requirements of 37 CFR 1.821-1.825.
- ☐ This application does not contain, a "Sequence Listing" as a separate part of the disclosure on paper copy or compact disc, as required by 37 CFR 1.821(c).
- ☐ A copy of the "Sequence Listing" in computer readable format has not been submitted as required by 37 CFR 1.821(e).
- ☐ A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
- ☐ The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ The paper copy or compact disc of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ Other: _____

APPLICANT MUST PROVIDE:

- ☐ An initial or substitute computer readable form (CRF) of the "Sequence Listing."
- ☒ An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- ☐ A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

FOR QUESTIONS REGARDING COMPLIANCE WITH THESE REQUIREMENTS, PLEASE
CALL:

(703) 308-4216, for Rules interpretation,
(703) 308-4212, for CRF submission help,
(703) 287-0200, for PatentIn software help.

Paulette Kidwell, Paralegal
Telephone: 703-305-3656



PTO/PCT Rec'd 25 JUN 2001

PATENT
Attorney Docket No. UCSD-04765

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: Ronald D. Vale *et al.*

Serial No.: 09/673,222

Group No.:

Filed: 10/13/00

Examiner:

Entitled: Assays for the Detection of Microtubule Depolymerization Inhibitors

AMENDMENT TO DRAWINGS UNDER 37 C.F.R. § 1.121(a)(3)

Assistant Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)(1)(i)(A)

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is, on the date shown below, being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Dated:

June 21, 2001

By:

Marilyn Moy
Marilyn Moy

Sir or Madam:

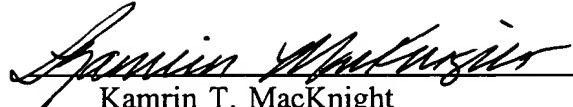
Applicant requests amendment of the original application drawings. Please substitute the originally-filed drawings, Fig. 1A, Substitute Sheet (Rule 26), and Fig. 1B, Substitute Sheet (Rule 26) with the attached Fig. 1A, Substitute Sheet, and Fig. 1B, Substitute Sheet.

Application Serial No. 09/673,222 (our file UCSD-04765) is a US National Entry of PCT application PCT/US99/08086 filed 4/13/99 (our file UCSD-04732).

The drawings at issue, Fig. 1A, Substitute Sheet (Rule 26) and Fig. 1B, Substitute Sheet (Rule 26) [Tab 1] filed in the instant application should be identical to the drawings filed on April 13, 1999 in PCT application PCT/US99/08086 [Tab 2]. An Invitation to Correct Defects was mailed to the Applicant on May 24, 1999 [Tab 3]. It has come to our attention that when Applicant responded to the Invitation to Correct Defects on July 26, 1999, the substitute sheets for Figs 1A and 1B [Tab 4] were different than what was originally filed on April 13, 1999.

Applicant respectfully requests that the drawings for Figs. 1A and 1B as originally filed on April 13, 1999 in PCT/US99/08086 be substituted for Fig. 1A and Fig. 1B in the instant application. The noted discrepancies are marked in red in Tab 5.

Dated: June 21, 2001


Kamrin T. MacKnight
Registration No. 38,230

MEDLEN & CARROLL, LLP
220 Montgomery Street, Suite 2200
San Francisco, California 94104
415.705.8410

004021-2222960

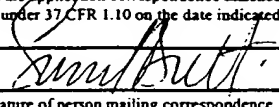
**TRANSMITTAL LETTER TO THE
UNITED STATES RECEIVING OFFICE**

Date	13 APRIL 1999
International Application No.	
Attorney Docket No.	18557B-5-1PC

I. Certification under 37 CFR 1.10 (if applicable)

EL104792308US	13 APRIL 1999
Express Mail mailing number	Date of Deposit

I hereby certify that the application/correspondence attached hereto is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

	Sunil Dutt
Signature of person mailing correspondence	Typed or printed name of person mailing correspondence

II. ☒ New International Application

TITLE	ASSAYS FOR THE DETECTION OF MICROTUBULE DEPOLYMERIZATION INHIBITORS	Earliest priority date (Day/Month/Year)
		13 APRIL 1998

SCREENING DISCLOSURE INFORMATION: In order to assist in screening the accompanying international application for purposes of determining whether a license for foreign transmittal should and could be granted and for other purposes, the following information is supplied. (Note: check as many boxes as apply):

- A. ☐ The invention disclosed was not made in the United States.
- B. ☐ There is no prior U.S. application relating to this invention.
- C. ☒ The following prior U.S. application(s) contain subject matter which is related to the invention disclosed in the attached international application. (NOTE: priority to these applications may or may not be claimed on form PCT/RO/101 (Request) and this listing does not constitute a claim for priority.)

application no.	60/081,734	filed on	14 APRIL 1998(14.04.98)
application no.		filed on	

- D. ☐ The present international application ☐ contains additional subject matter not found in the prior U.S. application(s) identified in paragraph C. above. The additional subject matter is found on pages and ☐ DOES NOT ALTER ☐ MIGHT BE CONSIDERED TO ALTER the general nature of the invention in a manner which would require the U.S. application to have been made available for inspection by the appropriate defense agencies under 35 U.S.C. 181 and 37 CFR 5.1. See 37 CFR 5.15

III. ☐ A Response to an Invitation from the RO/US. The following document(s) is(are) enclosed:

- A. ☐ A Request for An Extension of Time to File a Response
- B. ☐ A Power of Attorney (General or Regular)
- C. ☐ Replacement pages:

pages		of the request (PCT/RO/101)	pages		of the figures
pages		of the description	pages		of the abstract
pages		of the claims			

- D. ☐ Submission of Priority Documents

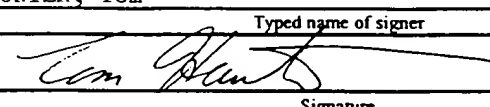
Priority document		Priority document	
-------------------	--	-------------------	--

- E. ☐ Fees as specified on attached Fee Calculation sheet form PCT/RO/101 annex

IV. ☐ A Request for Rectification under PCT 91 ☐ A Petition ☐ A Sequence Listing Diskette

V. ☐ Other (please specify):

The person
signing this
form is the:

<input type="checkbox"/> Applicant	HUNTER, Tom
<input checked="" type="checkbox"/> Attorney/Agent (Reg. No.) 38,498	Typed name of signer
<input type="checkbox"/> Common Representative	
	Signature

TOWNSEND
and
TOWNSEND
and
CREW
LLP

Denver, Colorado
Tel 303 571-4000

Palo Alto, California
Tel 650 326-2400

Seattle, Washington
Tel 206 467-9600

San Francisco

Two Embarcadero Center
Eighth Floor
San Francisco
California 94111-3834
Tel 415 576-0200
Fax 415 576-0300

July 26, 1999

Georgette Hill
PCT International Division
Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Re: THE REGENTS OF THE UNIVERSITY OF CALIFORNIA
International Application No.: PCT/US99/08086
filed 13 April 1999
Our File No.: 18557B-5-1PC

Dear Officer Hostad:

In response to the Invitation to Correct Defects dated 24 May 1999, please accept a corrected set of drawings at this time.

Please grant us an additional one month extension of the due date to submit new sheets of text .

Respectfully submitted,
TOWNSEND and TOWNSEND and CREW LLP

Kenneth A. Weber /ba

Kenneth A. Weber
Reg. No. 31,677

/ba

Encls.

TO THE U.S. PATENT & TRADEMARK OFFICE

Please stamp the date of receipt of the following document(s)
and return this card to us:

RE: Invitation to Correct Defects

TITLE OF DOCUMENT(S): a corrected set of drawings +
request for an additional one month extension to submit
new sheets of text.

Application No. PCT/US99/08086

File No. 18557B-5-1PC

Date Due 24 July 1999

Date Mailed 26 July 1999

Atty/Secty. KAW/ba

430 Rec'd PCT/PTO 26 JUL 1999 UNDOCKETED

004021-222296

The Examining Office has found that, with regard to the presentation of the drawings of the international application as filed, the technical requirements are not complied with to the extent that compliance therewith is necessary for:

- ☒ reasonably uniform international publication (Rules 11 and 26.3(a)(i)) (defects to be specified)

Sheets containing drawings:

- 6.24.99
- a. ☐ the sheets do not admit of direct reproduction.
 - b. ☐ the sheets are not free from creases, cracks, folds.
 - c. ☐ one side of the sheets is not left unused.
 - d. ☐ the paper of the sheets is not flexible/strong/white/smooth/non-shiny/durable.
 - e. ☐ the drawings do not commence on a new sheet.
 - f. ☐ the sheets are not connected as prescribed (Rule 11.4(b)).
 - g. ☐ the sheets are not A4 size (29.7cm x 21cm).
 - h. ☒ the minimum margins on the sheets are not as prescribed (top: 2.5cm; left side: 2.5cm; right side: 1.5cm; bottom: 1cm). FIG. 1A, 1B, 2B, 6
 - i. ☐ the file reference number indicated on the sheets does not appear in the left-hand corner of the sheets, within 1.5cm of the top of the sheets.
 - j. ☐ the file reference number exceeds the maximum of 12 characters.
 - k. ☐ the sheets are not free from frames around usable or used surfaces.
 - l. ☒ the sheets are not numbered in consecutive Arabic numerals (e.g. 1/3, 2/3, 3/3). ALL
 - m. ☐ the sheet numbers are not centered at the top or bottom of the sheets.
 - n. ☐ the sheet numbers are in the margin (see h. above for the size of the margins).
 - o. ☐ the sheets contain alterations/overwritings/interlineations/too many erasures.
 - p. ☐ the sheets contain photocopy marks.

BEST AVAILABLE CO

Drawings (Rule 11.13):

- a. ☐ do not admit of direct reproduction.
- b. ☐ contain unnecessary text matter.
- c. ☐ contain words so placed as to prevent translation without interference with lines thereof.
- d. ☐ are not executed in durable black color; the lines are not uniformly thick and well-defined.
- e. ☐ contain cross-sections not properly hatched.
- f. ☐ would not be properly distinguishable in reduced reproduction.
- g. ☐ contain scales not represented graphically.
- h. ☐ contain numbers, letters and reference lines lacking simplicity and clarity.
- i. ☐ contain lines drafted without the aid of drafting instruments.
- j. ☐ contain disproportionate elements of a figure not necessary for clarity.
- k. ☐ contain numbers and letters of height less than 0.32 cm.
- l. ☐ contain letters not conforming to the Latin, and where customary, Greek alphabets.
- m. ☐ contain figures on two or more sheets which form a single complete figure but which are not able to be assembled without concealing parts thereof.
- n. ☐ contain figures which are not properly arranged and clearly separated.
- o. ☐ contain different figures not numbered in consecutive Arabic numerals.
- p. ☐ contain different figures not numbered independent of the numbering of the sheets.
- q. ☐ are not restricted to reference signs mentioned in the description.
- r. ☐ do not contain reference signs that are mentioned in the description.
- s. ☐ contain the same feature denoted by different reference signs.
- t. ☒ are not arranged in an upright position, clearly separated from one another. FIG. 3, 4, 7
- u. ☐ are not presented sideways with the top of the figures at the left side of the sheets.

2. ☐ satisfactory reproduction (Rules 11 and 26.3(b)(i)).

Further observations (if necessary):

- Shading obj. FIG. 1B, 2B

- Photocopies of photographs are not permitted. FIG. 3, 4, 5B, 6, 7

NEW DRWGS REQD